



GREENBLUM & BERNSTEIN, P.L.C.
Intellectual Property Causes
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191

AF

Attorney Docket No. P18959

In re application of : Andres SANCHEZ

Application No. : 09/407,174

Group Art Unit: 2642

Filed : September 28, 1999

Examiner: W. J. Deane, Jr.

For : METHOD FOR MANAGING INFORMATION IN A TELEPHONE AND TELEPHONE FOR
MANAGING INFORMATION

Commissioner for Patents
U.S. Patent and Trademark Office
220 20th Street S.
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202
Sir:

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OCT 15 2004

Technology Center 2600

Transmitted herewith is an **Appeal Brief Under 37 C.F.R. § 1.192** in the above-captioned application.

_____ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.

_____ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.

_____ A Request for Extension of Time.

_____ No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 24	24	0	x 9=	\$0.00	x 18=	\$
Indep. Claims: 4	4	0	x 44=	\$0.00	x 88=	\$
Multiple Dependent Claims Presented			+150=	\$0.00	+300=	\$
Appeal Brief fee				\$170.00		\$
Total:				\$170.00	Total:	\$

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☒ A check in the amount of \$170.00 to cover the filing fee is included.

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☒ Any additional filing fees required under 37 C.F.R. 1.16.

☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 C.F.R. 1.136(a)(3)).

Neil F. Greenblum

Reg. No. 28,394

28,394



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant : Andres SANCHEZ)
) Group Art Unit: 2642
Appln. No. : 09/407,174)
) Examiner: W. J. Deane, Jr.
Filed : September 28, 1999)

For : METHOD FOR MANAGING INFORMATION IN A
TELEPHONE AND TELEPHONE FOR MANAGING
INFORMATION

APPEAL BRIEF UNDER 37 C.F.R. § 1.192

Commissioner for Patents
U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop _____
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

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Sir:

This appeal is from the Examiner's final rejection of claims 1-24 as set forth in the Final Office Action of February 11, 2004.

A Notice of Appeal in response to the February 11, 2004 Final Office Action was filed on August 10, 2004, the time to respond being October 12, 2004 (October 10, 2004 being a Sunday and October 11, 2004 being a Federal Holiday).

The requisite fee under 37 C.F.R. 41.20(b)(2) in the amount of \$ 170.00 for the filing of the Appeal Brief is being paid by check, submitted herewith. However, if for any reason the necessary fee is not associated with this file, the Commissioner is authorized to charge the fee for the Appeal Brief and any necessary extension of time fees to Deposit Account No. 19 - 0089.

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(1) REAL PARTY IN INTEREST

The real party in interest is Fenmore International LTD. by an assignment recorded in the U.S. Patent and Trademark Office on January 14, 2000 at Reel 010522 and Frame 0720.

(2) RELATED APPEALS AND INTERFERENCES

No related appeals and/or interferences are pending.

(3) STATUS OF THE CLAIMS

Claims 1-24 stand finally rejected.

(4) STATUS OF THE AMENDMENTS

An amendment under 37 C.F.R. § 1.116 was filed August 4, 2004 and the Examiner indicated in the Advisory Action mailed September 15, 2004 that this amendment was not entered. Appellant submits that no other amendments after final have been filed.

(5) SUMMARY OF THE CLAIMED SUBJECT MATTER

The present invention is directed to an electronic telephone apparatus and a method for managing pieces of information (data) relating to telephone number lists stored in the telephone, in which the display and use of the data is allowed only after an access code is input into the telephone (page 1, lines 9-12).

More specifically, the display and use of the stored data is allowed only after a personal secret access code, that is associated with a particular (specific) user of a plurality of users of the telephone, is entered by the user. Only the data associated with the specific user of the telephone (as identified by the input secret access code) will be made available to that individual. Accordingly, the present invention permits multiple

individuals to use a common telephone, while providing for the maximum privacy of each user's personal data (page 3, lines 5-11).

In particular, the following descriptions are made with respect to the independent claims and include references to particular parts of the specification. As such, the following are merely exemplary and are not a surrender of other aspects of the present invention that are also enabled by the present specification and that are directed to equivalent structures or methods within the scope of the claims.

Claim 1 is directed to a method for managing telephone data used with a telephone including storing telephone data related to at least one of incoming and outgoing telephone calls in a list (See for example figure 2, boxes 2-6), the telephone data including at least public telephone data (See for example page 8, line 13 through page 9, line 18 of the specification and box 5 of figure 2); and limiting list access to the public telephone data in the list of public telephone data (See for example figure 3, boxes 20-22), until such time as a user of the telephone inputs a personal secret access code, after which, the user has access to the public telephone data in the list of public telephone data (See for example page 11, line 16 through page 12, line 13) and to private telephone data in a list of private telephone data (See for example figure 3, box 23) that is associated with the inputted personal secret access code. Both the private telephone data and the public telephone data are stored in the telephone.

Claim 11 is directed to a telephone that manages integrally stored telephone data, including a memory (M of figure 1, see also figure 2 boxes 2-6) that stores telephone data related to at least one of incoming and outgoing telephone calls; and a personal secret access code entry device (T of figure 1, see also boxes 20-22 of figure 3) that enables a

user of the telephone to enter a personal secret access code. Access to said stored telephone data is limited to a public list containing public telephone data, until such time as the user enters said personal secret access code, after which, the user has access to said public telephone data contained in said public list and a private list (See for example figure 3, box 23) containing private telephone data that is associated with said inputted personal secret access code. Both the private telephone data and the public telephone data are stored in the telephone.

Claim 16 is directed to a method for managing data used with a telephone, including entering a personal secret access code into the telephone by a user of the telephone (boxes 20-23 of figure 3); creating a private list containing telephone numbers associated with the personal secret access code entered by the user (boxes 2-6 of figure 2). The telephone numbers contained in the private list are accessible after entry of the associated personal secret access code (23). The method also includes creating a public list containing telephone numbers (6) that is accessible by any user of the telephone without the need for entering a personal secret access code. The telephone numbers in both the private list and the public list are stored in the telephone.

Claim 23 is directed to a method for managing telephone data using a telephone that can be used by a plurality of users. The method includes storing in the telephone public type of telephone data related to at least one of incoming and outgoing telephone calls (box 6 of figure 2); storing in the telephone, for each of the plurality of users, private type of telephone data related to at least one of incoming and outgoing telephone calls (5); allowing each of the plurality of users to access to the public type of telephone data; preventing each of the plurality of users from accessing the private type of

telephone data until each of the plurality of users enters a personal secret access code; allowing one of the plurality of users to access the private type of telephone data upon input of a personal secret access code (boxes 20-23 of figure 3); and allowing another of the plurality of users to access the private type of telephone data upon input of a personal secret access code. Each of the plurality of users has a different personal secret access code, and the private type of telephone data that is accessible by the one of the plurality of users comprises telephone data that is different from the private type of telephone data that is accessible by the other of the plurality of users.

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

(A) Whether claims 1-9, 11, 12, 16-19, 23, and 24 are improperly rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 5,884,200 to YAMANE et al. [hereinafter "YAMANE et al"];

(B) Whether claims 10, 13-15, and 20-22 are improperly rejected under 35 U.S.C. § 103(a) as unpatentable over YAMANE et al.

(7) ARGUMENT

Traversal of Rejection of claims 1-9, 11, 12, 16-19, 23, and 24 Under 35 U.S.C. § 102(e) as being anticipated by YAMANE et al.

(A) Rejection of Claim 1

The rejection of claim 1 under 35 U.S.C. § 102(e) as being anticipated by YAMANE et al. is in error, the decision of the Examiner to finally reject this claim should be reversed, and the application should be remanded to the Examiner.

The Examiner asserted that this document discloses all the features recited in this claim including the use of public data and private data, and the use of ID codes. Appellant respectfully traverses this rejection.

Notwithstanding the Examiner's assertions as to what this document discloses, Appellant submits that this document fails to disclose, or even suggest: *inter alia*, storing telephone data related to at least one of incoming and outgoing telephone calls in a list, the telephone data at least including public telephone data, limiting list access to the public telephone data in the list, until such time as a user of the telephone inputs a personal secret access code, after which, the user has access to the public telephone data in the list of public telephone data and to private telephone data in a list of private telephone data that is associated with the inputted personal secret access code, wherein both the private telephone data and the public telephone data are stored in the telephone, as recited in claim 1.

As a preliminary matter, Appellant notes that YAMANE is not directed to a telephone which can be used by multiple individuals, while providing for the maximum privacy of each user's personal data.

The YAMANE et al. radio communication apparatus (mobile telephone) is directed to communication via base stations connected to communication networks. The YAMANE et al. radio communication apparatus stores a plurality of identification codes and designates one of the plurality of identification codes stored in a storing means to be used. The YAMANE et al. radio communication apparatus includes means for performing calling process on the basis of the identification code designated by a designating means (see column 1, lines 44-51 of YAMANE et al.). In general, such an

identification code is stored in a memory in a radio communication apparatus, and authentication with respect to each base station or a communication network side (communication network management station) is performed to permit speech communication (See column 1, lines 16-19 of YAMANE et al.).

In contrast, the present invention stores telephone data (e.g. telephone numbers (See page 9, lines 10-12)) related to at least one of incoming and outgoing telephone calls in a list. The telephone data (e.g. telephone numbers) of the present invention is wholly distinct from the YAMANE et al. identification code that is stored in a memory in a radio communication apparatus and that is used for authentication purposes with respect to each base station or a communication network. More specifically, the control section 1a of YAMANE et al. sets one of a plurality of identification codes which is to be used in a calling operation. With this identification code setting process, one of the plurality of identification codes stored in predetermined areas of the ROM 10 and the ID memory 20 is read out and set in the TDMA processing section 5 (see column 4, lines 5-10). Thus, YAMANE et al. does not disclose, *inter alia*, storing telephone data related to at least one of incoming and outgoing telephone calls in a list as recited by claim 1. YAMANE et al. merely uses the identification codes to identify the telephone to either one of a private or public telephone network.

Furthermore, the present invention includes limiting list access to the public telephone data in the list, until such time as a user of the telephone inputs a personal secret access code, after which, the user has access to the public telephone data in the list of public telephone data and to private telephone data in a list of private telephone data that is associated with the inputted personal secret access code.

Contrary to this, YAMANE et al. does not disclose any such feature. In fact, the Final Official action does not indicate any particular portion of YAMANE et al. that discloses limiting list access or any type of personal secret access code. Thus, Appellants submit that YAMANE et al. does not disclose, *inter alia*, limiting list access to the public telephone data in the list, until such time as a user of the telephone inputs a personal secret access code, after which, the user has access to the public telephone data in the list of public telephone data and to private telephone data in a list of private telephone data that is associated with the inputted personal secret access code as recited by claim 1.

Appellant respectfully asserts that, as YAMANE et al. does not disclose each and every feature of claim 1, this Examiner has failed to provide an adequate evidentiary basis to support an anticipation rejection under 35 U.S.C. § 102(e).

Accordingly, Appellant respectfully requests that the Examiner's decision to finally reject claim 1 under 35 U.S.C. § 102(e) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over YAMANE et al. and an early allowance of all claims on appeal.

(B) Rejection of Claim 11

The rejection of claim 11 under 35 U.S.C. § 102(e) as being anticipated by YAMANE et al. is in error, the decision of the Examiner to finally reject this claim should be reversed, and the application should be remanded to the Examiner.

The Examiner asserted that this document discloses all the features recited in this claim including the use of public data and private data, and the use of ID codes. Appellant respectfully traverses this rejection.

Notwithstanding the Examiner's assertions as to what this document discloses, Appellant submits that this document fails to disclose, or even suggest: *inter alia*, a memory that stores telephone data related to at least one of incoming and outgoing telephone calls and a personal secret access code entry device that enables a user of the telephone to enter a personal secret access code, access to said stored telephone data being limited to a public list containing public telephone data, until such time as the user enters said personal secret access code, after which, the user has access to said public telephone data contained in said public list and a private list containing private telephone data that is associated with said inputted personal secret access code, wherein both the private telephone data and the public telephone data are stored in the telephone, as recited in amended claim 11.

As noted above, the present invention stores telephone data (e.g. telephone numbers (See page 9, lines 10-12)) related to at least one of incoming and outgoing telephone calls in a list. The telephone data (e.g. telephone numbers) of the present invention is distinct from the YAMANE et al. identification code that is stored in a memory in a radio communication apparatus and that is used for authentication purposes with respect to each base station or a communication network. Thus, YAMANE et al. does not disclose, *inter alia*, a memory that stores telephone data related to at least one of incoming and outgoing telephone calls and a personal secret access code entry device that enables a user of the telephone to enter a personal secret access code as recited by claim 11.

Furthermore, the present invention includes a personal secret access code entry device that enables a user of the telephone to enter a personal secret access code, access

to said stored telephone data being limited to a public list containing public telephone data, until such time as the user enters said personal secret access code.

As previously noted, YAMANE et al. does not disclose any such feature, nor does the Final Official action indicate any particular portion of YAMANE et al. that purportedly discloses limiting list access or any use of a personal secret access code. Thus, Appellants submit that YAMANE et al. does not disclose, *inter alia*, a personal secret access code entry device that enables a user of the telephone to enter a personal secret access code, access to said stored telephone data being limited to a public list containing public telephone data, until such time as the user enters said personal secret access code as recited by claim 11.

Appellant respectfully asserts that, as YAMANE et al. does not disclose each and every feature of claim 11, this Examiner has failed to provide an adequate evidentiary basis to support an anticipation rejection under 35 U.S.C. § 102(e).

Accordingly, Appellant respectfully requests that the Examiner's decision to finally reject claim 11 under 35 U.S.C. § 102(e) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over YAMANE et al. and an early allowance of all claims on appeal.

(C) Rejection of Claim 16

The rejection of claim 16 under 35 U.S.C. § 102(e) as being anticipated by YAMANE et al. is in error, the decision of the Examiner to finally reject this claim should be reversed, and the application should be remanded to the Examiner.

The Examiner asserted that this document discloses all the features recited in this claim including the use of public data and private data, and the use of ID codes. Appellant respectfully traverses this rejection.

Notwithstanding the Examiner's assertions as to what this document discloses, Appellant submits that this document fails to disclose, or even suggest: *inter alia*, entering a personal secret access code into the telephone by a user of the telephone, creating a private list containing telephone numbers associated with the personal secret access code entered by the user, the telephone numbers contained in the private list being accessible after entry of the associated personal secret access code, and creating a public list containing telephone numbers that is accessible by any user of the telephone without the need for entering a personal secret access code, wherein the telephone numbers in both the private list and the public list are stored in the telephone, as recited in amended claim 16.

In contrast, Appellants submit that YAMANE et al. does not disclose each of the above-noted features and that the Examiner's Final Official action does not identify any particular portion of YAMANE et al. disclosing creating a private list containing telephone numbers associated with the personal secret access code entered by the user, the telephone numbers contained in the private list being accessible after entry of the associated personal secret access code as recited by claim 16.

As noted above, the YAMANE et al. identification code is stored in a memory in a radio communication apparatus and is used for authentication purposes with respect to each base station or a communication network. More specifically, one identification code

is selected from a plurality of identification codes by operating the key input section 8, and a calling operation is performed (See column 9, lines 61-62).

The YAMANE et al. identification code does not anticipate or disclose, *inter alia*, entering a personal secret access codes, creating a private list containing telephone numbers, or creating a public list containing telephone numbers as recited by claim 16.

Appellant respectfully asserts that, as YAMANE et al. does not disclose each and every feature of claim 16, this Examiner has failed to provide an adequate evidentiary basis to support an anticipation rejection under 35 U.S.C. § 102(e).

Accordingly, Appellant respectfully requests that the Examiner's decision to finally reject claim 16 under 35 U.S.C. § 102(e) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over YAMANE et al. and an early allowance of all claims on appeal.

(D) Rejection of Claim 23

The rejection of claim 23 under 35 U.S.C. § 102(e) as being anticipated by YAMANE et al. is in error, the decision of the Examiner to finally reject this claim should be reversed, and the application should be remanded to the Examiner.

The Examiner asserted that this document discloses all the features recited in this claim including the use of public data and private data, and the use of ID codes. Appellant respectfully traverses this rejection.

Notwithstanding the Examiner's assertions as to what this document discloses, Appellant submits that this document fails to disclose, or even suggest: *inter alia*, storing in the telephone public type of telephone data related to at least one of incoming and outgoing telephone calls, storing in the telephone, for each of the plurality of users,

private type of telephone data related to at least one of incoming and outgoing telephone calls, allowing each of the plurality of users to access to the public type of telephone data, preventing each of the plurality of users from accessing the private type of telephone data until each of the plurality of users enters a personal secret access code, allowing one of the plurality of users to access the private type of telephone data upon input of a personal secret access code, and allowing another of the plurality of users to access the private type of telephone data upon input of a personal secret access code, wherein each of the plurality of users has a different personal secret access code, and wherein the private type of telephone data that is accessible by the one of the plurality of users comprises telephone data that is different from the private type of telephone data that is accessible by the other of the plurality of users as recited in amended claim 23.

As previously noted, the present invention stores telephone data (e.g. telephone numbers (See page 9, lines 10-12)) related to at least one of incoming and outgoing telephone calls in a list. The telephone data (e.g. telephone numbers) of the present invention is entirely distinct and different from the YAMANE et al. identification code that is stored in a memory in a radio communication apparatus and that is used for authentication purposes with respect to each base station or a communication network.

Thus, YAMANE et al. does not disclose, *inter alia*, storing in the telephone public type of telephone data related to at least one of incoming and outgoing telephone calls, and storing in the telephone, for each of the plurality of users, private type of telephone data related to at least one of incoming and outgoing telephone calls as recited by claim 23.

Moreover, the official action does not address nor does YAMANE et al. disclose, preventing each of the plurality of users from accessing the private type of telephone data until each of the plurality of users enters a personal secret access code, allowing one of the plurality of users to access the private type of telephone data upon input of a personal secret access code, and allowing another of the plurality of users to access the private type of telephone data upon input of a personal secret access code as recited by claim 23.

Appellant respectfully asserts that, as YAMANE et al. does not disclose each and every feature of claim 23, this Examiner has failed to provide an adequate evidentiary basis to support an anticipation rejection under 35 U.S.C. § 102(e).

Accordingly, Appellant respectfully requests that the Examiner's decision to finally reject claim 23 under 35 U.S.C. § 102(e) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over YAMANE et al. and an early allowance of all claims on appeal.

(E) Rejection of Claim 2

The rejection of claim 2 under 35 U.S.C. § 102(e) as being anticipated by YAMANE et al. is in error, the decision of the Examiner to finally reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellant submits that dependent claim 2 is allowable at least for the reason that this claim depends from an allowable base claim and because this claim recites additional features that further define the present invention.

Moreover, Appellant submits that no proper reading of YAMANE discloses or even suggests, in combination, *inter alia*: that the method further comprises displaying on

a display associated with the telephone at least one of the list of public telephone data and the list of private telephone data as recited in claim 2.

YAMANE et al. discloses the display section 9 displays input data for various control operations and the resultant data. YAMANE et al. does not disclose displaying on a display associated with the telephone at least one of the list of public telephone data and the list of private telephone data as recited in claim 2.

Accordingly, Appellant respectfully requests that the Examiner's decision to finally reject claim 2 under 35 U.S.C. § 102(e) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over YAMANE et al. and an early allowance of all claims on appeal.

(F) Rejection of Claim 3

The rejection of claim 3 under 35 U.S.C. § 102(e) as being anticipated by YAMANE et al. is in error, the decision of the Examiner to finally reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellant submits that dependent claim 3 is allowable at least for the reason that this claim depends from an allowable base claim and because this claim recites additional features that further define the present invention.

Moreover, Appellant submits that no proper reading of YAMANE et al. discloses or even suggests, in combination, *inter alia*: that the list of public telephone data comprises a public list and the list of private telephone data comprises a private list as recited in claim 3.

As noted above, the telephone data (e.g. telephone numbers) of the present invention is entirely distinct and different from the YAMANE et al. identification code

that is stored in a memory in a radio communication apparatus and that is used for authentication purposes with respect to each base station or a communication network.

Thus, YAMANE et al. does not disclose the list of public telephone data and moreover the list of public telephone data that comprises a public list and the list of private telephone data comprises a private list.

Accordingly, Appellant respectfully requests that the Examiner's decision to finally reject claim 3 under 35 U.S.C. § 102(e) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over YAMANE et al. and an early allowance of all claims on appeal.

(G) Rejection of Claim 4

The rejection of claim 4 under 35 U.S.C. § 102(e) as being anticipated by YAMANE et al. is in error, the decision of the Examiner to finally reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellant submits that dependent claim 4 is allowable at least for the reason that this claim depends from an allowable base claim and because this claim recites additional features that further define the present invention.

Moreover, Appellant submits that no proper reading of YAMANE et al. discloses or even suggests, in combination, *inter alia*: that the inputting of a personal secret access code comprises manipulating a predetermined key sequence on a keypad of the telephone to initiate an operation to enter the personal secret access code as recited in claim 4.

As noted above, YAMANE et al. does not disclose a personal secret access code. Thus YAMANE et al. does not also disclose inputting of a personal secret access code

comprises manipulating a predetermined key sequence on a keypad of the telephone to initiate an operation to enter the personal secret access code.

Accordingly, Appellant respectfully requests that the Examiner's decision to finally reject claim 4 under 35 U.S.C. § 102(e) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over YAMANE et al. and an early allowance of all claims on appeal.

(H) Rejection of Claim 5

The rejection of claim 5 under 35 U.S.C. § 102(e) as being anticipated by YAMANE et al. is in error, the decision of the Examiner to finally reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellant submits that dependent claim 5 is allowable at least for the reason that this claim depends from an allowable base claim and because this claim recites additional features that further define the present invention.

Moreover, Appellant submits that no proper reading of YAMANE et al. discloses or even suggests, in combination, *inter alia*: storing the public telephone data and the private telephone data in the respective lists of public telephone data and private telephone data on a common list, the private telephone data being hidden from the user until the user inputs the personal secret access code as recited in claim 5.

As noted above, YAMANE et al. does not disclose a list of public telephone data and moreover a list of public telephone data that comprises a public list and the list of private telephone data comprises a private list. Thus, YAMANE et al. also does not disclose the private telephone data being hidden from the user until the user inputs the personal secret access code as recited in claim 5.

Accordingly, Appellant respectfully requests that the Examiner's decision to finally reject claim 5 under 35 U.S.C. § 102(e) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over YAMANE et al. and an early allowance of all claims on appeal.

(I) Rejection of Claim 6

The rejection of claim 6 under 35 U.S.C. § 102(e) as being anticipated by YAMANE et al. is in error, the decision of the Examiner to finally reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellant submits that dependent claim 6 is allowable at least for the reason that this claim depends from an allowable base claim and because this claim recites additional features that further define the present invention.

Moreover, Appellant submits that no proper reading of YAMANE et al. discloses or even suggests, in combination, *inter alia*: that the method further comprises providing two operating modes of the telephone, a first mode that has no access restrictions, and a second mode with access restrictions as recited in claim 6.

The Examiner has attempted to rely on the doctrine of inherency in order to overcome the lack of disclosure of YAMANE et al. However, in "relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461,1464 (Bd. Pat. App. & Inter. 1990). The Examiner has failed to provide any such reasoning. Furthermore, the Examiner's conclusive statements do not provide that such features are certain to be in the YAMANE et al. disclosure. "The fact that a certain result

or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed.Cir.1993)(reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art).

Specifically, the Examiner has broadly concluded that several features are inherent in YAMANE et al. without providing any evidence or proper reasoning or setting forth how these features correspond to the claims. Appellant respectfully asserts that the Examiner has failed to provide any proper reasoning or evidence necessary to conclude that providing two operating modes of the telephone, a first mode that has no access restrictions, and a second mode with access restrictions as recited in claim 6 is inherent to YAMANE et al.

Accordingly, Appellant respectfully requests that the Examiner's decision to finally reject claim 6 under 35 U.S.C. § 102(e) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over YAMANE et al. and an early allowance of all claims on appeal.

(J) Rejection of Claim 7

The rejection of claim 7 under 35 U.S.C. § 102(e) as being anticipated by YAMANE et al. is in error, the decision of the Examiner to finally reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellant submits that dependent claim 7 is allowable at least for the reason that this claim depends from an allowable base claim and because this claim recites additional features that further define the present invention.

Moreover, Appellant submits that no proper reading of YAMANE et al. discloses or even suggests, in combination, *inter alia*: that the method further comprises rejecting an incoming call, and blocking of any indication of the incoming call, when a telephone number is designated as a protected telephone number as recited in claim 7.

The Examiner indicates that YAMANE et al. claim 4 discloses in the above-noted features. However, YAMANE et al. only discloses the call-incoming state includes at least one of communication, automatic answering, and communication rejection states. YAMANE et al. does not disclose, *inter alia*, rejecting an incoming call, and blocking of any indication of the incoming call, when a telephone number is designated as a protected telephone number as recited in claim 7.

Accordingly, Appellant respectfully requests that the Examiner's decision to finally reject claim 7 under 35 U.S.C. § 102(e) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over YAMANE et al. and an early allowance of all claims on appeal.

(K) Rejection of Claim 8

The rejection of claim 8 under 35 U.S.C. § 102(e) as being anticipated by YAMANE et al. is in error, the decision of the Examiner to finally reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellant submits that dependent claim 8 is allowable at least for the reason that this claim depends from an allowable base claim and because this claim recites additional features that further define the present invention.

Moreover, Appellant submits that no proper reading of YAMANE discloses or even suggests, in combination, *inter alia*: that the method further comprises switching

between the two operating modes by manipulating a predetermined keyboard command as recited in claim 8.

The Examiner has broadly concluded these features are inherent in YAMANE et al. without providing any evidence or proper reasoning or setting forth how these features correspond to the claims. Appellant respectfully asserts that the Examiner has failed to provide any proper reasoning or evidence necessary to conclude that any of the features of the present claim are inherent to YAMANE et al. Appellant respectfully asserts that YAMANE et al. does render inherent, *inter alia*, switching between the two operating modes by manipulating a predetermined keyboard command as recited in claim 8.

Accordingly, Appellant respectfully requests that the Examiner's decision to finally reject claim 8 under 35 U.S.C. § 102(e) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over YAMANE et al. and an early allowance of all claims on appeal.

(L) Rejection of Claim 9

The rejection of claim 9 under 35 U.S.C. § 102(e) as being anticipated by YAMANE et al. is in error, the decision of the Examiner to finally reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellant submits that dependent claim 9 is allowable at least for the reason that this claim depends from an allowable base claim and because this claim recites additional features that further define the present invention.

Moreover, Appellant submits that no proper reading of YAMANE discloses or even suggests, in combination, *inter alia*: that the predetermined keyboard command

comprises manipulating one of a particular sequence of commands and a plurality of contemporary commands as recited in claim 9.

The Examiner has broadly concluded these features are inherent in YAMANE et al. without providing any evidence or proper reasoning or setting forth how these features correspond to the claims. Appellant respectfully asserts that the Examiner has failed to provide any proper reasoning or evidence necessary to conclude that any of the features of the present claim are inherent to YAMANE et al. Appellant respectfully asserts that YAMANE et al. does not render inherent, *inter alia*, manipulating one of a particular sequence of commands and a plurality of contemporary commands as recited in claim 9.

Accordingly, Appellant respectfully requests that the Examiner's decision to finally reject claim 9 under 35 U.S.C. § 102(e) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over YAMANE et al. and an early allowance of all claims on appeal.

(M) Rejection of Claim 12

The rejection of claim 12 under 35 U.S.C. § 102(e) as being anticipated by YAMANE et al. is in error, the decision of the Examiner to finally reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellant submits that dependent claim 12 is allowable at least for the reason that this claim depends from an allowable base claim and because this claim recites additional features that further define the present invention.

Moreover, Appellant submits that no proper reading of YAMANE discloses or even suggests, in combination, *inter alia*: that the telephone further comprises a display that provides a visual indication of at least one of said public telephone data contained in

said public list and said private telephone data contained in said private list as recited in claim 12.

YAMANE et al. discloses the display section 9 displays input data for various control operations and the resultant data. YAMANE et al. does not disclose and the Examiner does not suggest how YAMANE et al. discloses a display that provides a visual indication of at least one of said public telephone data contained in said public list and said private telephone data contained in said private list.

Accordingly, Appellant respectfully requests that the Examiner's decision to finally reject claim 12 under 35 U.S.C. § 102(e) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over YAMANE et al. and an early allowance of all claims on appeal.

(N) Rejection of Claim 17

The rejection of claim 17 under 35 U.S.C. § 102(e) as being anticipated by YAMANE et al. is in error, the decision of the Examiner to finally reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellant submits that dependent claim 17 is allowable at least for the reason that this claim depends from an allowable base claim and because this claim recites additional features that further define the present invention.

Moreover, Appellant submits that no proper reading of YAMANE discloses or even suggests, in combination, *inter alia*: that the method further comprises preventing the user from being notified of an incoming call when the telephone number of the incoming call is designated as a private telephone number and the user that designated the

incoming call as a private telephone number is not a current user of the telephone as recited in claim 17.

The Examiner indicates that YAMANE et al. claim 4 discloses in the above-noted features. However, YAMANE et al. only discloses the call-incoming state includes at least one of communication, automatic answering, and communication rejection states. YAMANE et al. does not disclose preventing the user from being notified of an incoming call when the telephone number of the incoming call is designated as a private telephone number and the user that designated the incoming call as a private telephone number is not a current user of the telephone.

Accordingly, Appellant respectfully requests that the Examiner's decision to finally reject claim 17 under 35 U.S.C. § 102(e) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over YAMANE et al. and an early allowance of all claims on appeal.

(O) Rejection of Claim 18

The rejection of claim 18 under 35 U.S.C. § 102(e) as being anticipated by YAMANE et al. is in error, the decision of the Examiner to finally reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellant submits that dependent claim 18 is allowable at least for the reason that this claim depends from an allowable base claim and because this claim recites additional features that further define the present invention.

Moreover, Appellant submits that no proper reading of YAMANE discloses or even suggests, in combination, *inter alia*: that the method further comprises storing a plurality of personal secret access codes, the telephone numbers in the private list being

associated with various personal secret access codes, a current personal secret access code entered into the telephone by a current user being limited to accessing telephone numbers in the private list that are associated with the current personal secret access code entered by the current user as recited in claim 18.

The official action neither addresses nor does YAMANE et al. disclose in any manner personal secret access codes or telephone numbers in a list as noted above. Moreover, YAMANE et al. does not disclose storing a plurality of personal secret access codes with the telephone numbers in the private list being associated with various personal secret access codes.

Accordingly, Appellant respectfully requests that the Examiner's decision to finally reject claim 18 under 35 U.S.C. § 102(e) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over YAMANE et al. and an early allowance of all claims on appeal.

(P) Rejection of Claim 19

The rejection of claim 19 under 35 U.S.C. § 102(e) as being anticipated by YAMANE et al. is in error, the decision of the Examiner to finally reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellant submits that dependent claim 19 is allowable at least for the reason that this claim depends from an allowable base claim and because this claim recites additional features that further define the present invention.

Moreover, Appellant submits that no proper reading of YAMANE discloses or even suggests, in combination, *inter alia*: that the method further comprises preventing the current user from being notified of an incoming call when the incoming call is

designated as a private telephone number associated with a personal secret access code that differs from that of the current user as recited in claim 19.

The Examiner indicates that YAMANE et al. claim 4 discloses in the above-noted features. However, YAMANE et al. only discloses the call-incoming state includes at least one of communication, automatic answering, and communication rejection states. YAMANE et al. does not disclose preventing the current user from being notified of an incoming call when the incoming call is designated as a private telephone number associated with a personal secret access code that differs from that of the current user.

Accordingly, Appellant respectfully requests that the Examiner's decision to finally reject claim 19 under 35 U.S.C. § 102(e) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over YAMANE et al. and an early allowance of all claims on appeal.

(Q) Rejection of Claim 24

The rejection of claim 24 under 35 U.S.C. § 102(e) as being anticipated by YAMANE et al. is in error, the decision of the Examiner to finally reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellant submits that dependent claim 24 is allowable at least for the reason that this claim depends from an allowable base claim and because this claim recites additional features that further define the present invention.

Moreover, Appellant submits that no proper reading of YAMANE discloses or even suggests, in combination, *inter alia*: and a telephone which can be used to practice the method of claim 23, wherein the telephone includes a display, a keypad and a storage

device which stores both the public type and the private type of telephone data as recited in claim 24.

The official action neither addresses nor does YAMANE et al. disclose in any of the features of claim 23. Moreover, YAMANE et al. does not disclose, *inter alia*, a storage device which stores both the public type and the private type of telephone data as recited in claim 24.

Accordingly, Appellant respectfully requests that the Examiner's decision to finally reject claim 24 under 35 U.S.C. § 102(e) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over YAMANE et al. and an early allowance of all claims on appeal.

**Traversal of rejection of claims 10, 13-15, and 20-22 under 35 U.S.C. § 103(a) as
being unpatentable over YAMANE et al.**

(R) Rejection of Claim 10

The rejection of claim 10 under 35 U.S.C. § 103(a) as being unpatentable over YAMANE et al. is in error, the decision of the Examiner to finally reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellant submits that dependent claim 10 is allowable at least for the reason that this claim depends from an allowable base claim and because this claim recites additional features that further define the present invention.

Moreover, Appellant submits that no proper combination of the applied documents discloses or suggests, in combination, *inter alia*: that the method further comprises delaying the switching between the two operating modes until the user inputs the personal secret access code as recited in claim 10.

Appellant submits that there is no motivation to modify YAMANE in a manner which would render obvious Appellant's invention, and additionally, Appellant submits that there is no motivation or rationale disclosed or suggested in the prior art to modify the applied reference to allow inputting access codes as suggested by the Examiner. The Examiner's opinion does not provide a proper basis for these features or for the motivation to modify any of these documents, or their combination, in the manner suggested by the Examiner. Therefore, Appellant submits that the invention as recited in at least independent claims 1, 11 and 16 is not rendered obvious by any reasonable inspection and interpretation of the disclosure of the applied references.

Accordingly, Appellant respectfully requests that the Examiner's decision to finally reject claim 10 under 35 U.S.C. § 103(a) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over YAMANE et al. and an early allowance of all claims on appeal.

(S) Rejection of Claim 13

The rejection of claim 13 under 35 U.S.C. § 103(a) as being unpatentable over YAMANE et al. is in error, the decision of the Examiner to finally reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellant submits that dependent claim 13 is allowable at least for the reason that this claim depends from an allowable base claim and because this claim recites additional features that further define the present invention.

Moreover, Appellant submits that no proper combination of the applied documents discloses or suggests, in combination, *inter alia*: that the telephone further comprises an inhibitor that prevents at least one of a visual indication and an audible

indication of an incoming call when a telephone number of said incoming call is designated to be a private call corresponding to a personal secret access code that has not been inputted into said telephone by a current user of said telephone as recited in claim 13.

Appellant submits that there is no motivation to modify YAMANE in a manner which would render obvious Appellant's invention, and additionally, Appellant submits that there is no motivation or rationale disclosed or suggested in the prior art to modify the applied reference to turn off a visual or audible indication as suggested by the Examiner. The Examiner's opinion does not provide a proper basis for these features or for the motivation to modify any of these documents, or their combination, in the manner suggested by the Examiner. Therefore, Appellant submits that the invention as recited in at least independent claims 1, 11 and 16 is not rendered obvious by any reasonable inspection and interpretation of the disclosure of the applied references.

Accordingly, Appellant respectfully requests that the Examiner's decision to finally reject claim 13 under 35 U.S.C. § 103(a) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over YAMANE et al. and an early allowance of all claims on appeal.

(T) Rejection of Claim 14

The rejection of claim 14 under 35 U.S.C. § 103(a) as being unpatentable over YAMANE et al. is in error, the decision of the Examiner to finally reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellant submits that dependent claim 14 is allowable at least for the reason that this claim depends from an allowable base claim and because this claim recites additional features that further define the present invention.

Moreover, Appellant submits that no proper combination of the applied documents discloses or suggests, in combination, *inter alia*: that said personal secret access code is inputted by manipulating a predetermined key sequence on a keypad of said telephone to initiate an operation to enter said personal secret access code as recited in claim 14.

Appellant submits that there is no motivation to modify YAMANE in a manner which would render obvious Appellant's invention, and additionally, Appellant submits that there is no motivation or rationale disclosed or suggested in the prior art to modify the applied reference to allow inputting access codes as suggested by the Examiner. The Examiner's opinion does not provide a proper basis for these features or for the motivation to modify any of these documents, or their combination, in the manner suggested by the Examiner. Therefore, Appellant submits that the invention as recited in at least independent claims 1, 11 and 16 is not rendered obvious by any reasonable inspection and interpretation of the disclosure of the applied references.

Accordingly, Appellant respectfully requests that the Examiner's decision to finally reject claim 14 under 35 U.S.C. § 103(a) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over YAMANE et al. and an early allowance of all claims on appeal.

(U) Rejection of Claim 15

The rejection of claim 15 under 35 U.S.C. § 103(a) as being unpatentable over YAMANE et al. is in error, the decision of the Examiner to finally reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellant submits that dependent claim 15 is allowable at least for the reason that this claim depends from an allowable base claim and because this claim recites additional features that further define the present invention.

Appellant submits that there is no motivation to modify YAMANE in a manner which would render obvious Appellant's invention, and additionally, Appellant submits that there is no motivation or rationale disclosed or suggested in the prior art to modify the applied reference to have timed access as suggested by the Examiner. The Examiner's opinion does not provide a proper basis for these features or for the motivation to modify any of these documents, or their combination, in the manner suggested by the Examiner. Therefore, Appellant submits that the invention as recited in at least independent claims 1, 11 and 16 is not rendered obvious by any reasonable inspection and interpretation of the disclosure of the applied references.

Moreover, Appellant submits that no proper combination of the applied documents discloses or suggests, in combination, *inter alia*: that said personal secret access code is inputted by manipulating a predetermined sequence of simultaneous commands for a predetermined time period on a keypad of said telephone to initiate an operation to enter said personal secret access code as recited in claim 15.

Accordingly, Appellant respectfully requests that the Examiner's decision to finally reject claim 15 under 35 U.S.C. § 103(a) be reversed, and that the application be

remanded to the Examiner for withdrawal of the rejection over YAMANE et al. and an early allowance of all claims on appeal.

(V) Rejection of Claim 20

The rejection of claim 20 under 35 U.S.C. § 103(a) as being unpatentable over YAMANE et al. is in error, the decision of the Examiner to finally reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellant submits that dependent claim 20 is allowable at least for the reason that this claim depends from an allowable base claim and because this claim recites additional features that further define the present invention.

Moreover, Appellant submits that no proper combination of the applied documents discloses or suggests, in combination, *inter alia*: that the method further comprises switching between a public operating mode and a private operating mode by manipulating a predetermined command on a keyboard of the telephone as recited in claim 20.

Appellant submits that there is no motivation to modify YAMANE in a manner which would render obvious Appellant's invention, and additionally, Appellant submits that there is no motivation or rationale disclosed or suggested in the prior art to modify the applied reference to allow inputting an access code as suggested by the Examiner. The Examiner's opinion does not provide a proper basis for these features or for the motivation to modify any of these documents, or their combination, in the manner suggested by the Examiner. Therefore, Appellant submits that the invention as recited in at least independent claims 1, 11 and 16 is not rendered obvious by any reasonable inspection and interpretation of the disclosure of the applied references.

Accordingly, Appellant respectfully requests that the Examiner's decision to finally reject claim 20 under 35 U.S.C. § 103(a) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over YAMANE et al. and an early allowance of all claims on appeal.

(W) Rejection of Claim 21

The rejection of claim 21 under 35 U.S.C. § 103(a) as being unpatentable over YAMANE et al. is in error, the decision of the Examiner to finally reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellant submits that dependent claim 21 is allowable at least for the reason that this claim depends from an allowable base claim and because this claim recites additional features that further define the present invention.

Moreover, Appellant submits that no proper combination of the applied documents discloses or suggests, in combination, *inter alia*: that entering the personal secret access code comprises manipulating a predetermined key on a keypad of the telephone for a predetermined period of time to initiate an operation to enter the personal secret access code as recited in claim 21.

Appellant submits that there is no motivation to modify YAMANE in a manner which would render obvious Appellant's invention, and additionally, Appellant submits that there is no motivation or rationale disclosed or suggested in the prior art to modify the applied reference to allow inputting an access code as suggested by the Examiner. The Examiner's opinion does not provide a proper basis for these features or for the motivation to modify any of these documents, or their combination, in the manner suggested by the Examiner. Therefore, Appellant submits that the invention as recited in

at least independent claims 1, 11 and 16 is not rendered obvious by any reasonable inspection and interpretation of the disclosure of the applied references.

Accordingly, Appellant respectfully requests that the Examiner's decision to finally reject claim 21 under 35 U.S.C. § 103(a) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over YAMANE et al. and an early allowance of all claims on appeal.

(X) Rejection of Claim 22

The rejection of claim 22 under 35 U.S.C. § 103(a) as being unpatentable over YAMANE et al. is in error, the decision of the Examiner to finally reject this claim should be reversed, and the application should be remanded to the Examiner.

Appellant submits that dependent claim 22 is allowable at least for the reason that this claim depends from an allowable base claim and because this claim recites additional features that further define the present invention.

Moreover, Appellant submit that no proper combination of the applied documents discloses or suggests, in combination, *inter alia*: and that entering the personal secret access code comprises manipulating a predetermined sequence of simultaneous commands on a keypad of the telephone for a predetermined period of time to initiate an operation to enter the personal secret access code as recited in claim 22.

Appellant submits that there is no motivation to modify YAMANE in a manner which would render obvious Appellant's invention, and additionally, Appellant submits that there is no motivation or rationale disclosed or suggested in the prior art to modify the applied reference to have time access as suggested by the Examiner. The Examiner's opinion does not provide a proper basis for these features or for the motivation to modify

any of these documents, or their combination, in the manner suggested by the Examiner. Therefore, Appellant submits that the invention as recited in at least independent claims 1, 11 and 16 is not rendered obvious by any reasonable inspection and interpretation of the disclosure of the applied references.

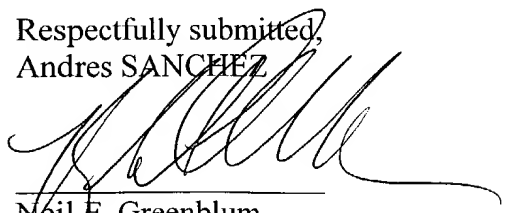
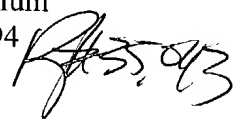
Accordingly, Appellant respectfully requests that the Examiner's decision to finally reject claim 22 under 35 U.S.C. § 103(a) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over YAMANE et al. and an early allowance of all claims on appeal.

(E) CONCLUSION

Each of claims 1-24 are patentable under 35 U.S.C. § 103(a) and 35 U.S.C. § 102(e) over. Specifically, the applied art of record, even in properly combined, fails to disclose or suggest the unique combination of features recited in Appellant's claims 1-24. Accordingly, Appellant respectfully requests that the Board reverse the decision of the Examiner to reject claims 1-24 under 35 U.S.C. § 103(a) and 35 U.S.C. § 102(e) and remand the application to the Examiner for withdrawal of the rejection.

Thus, Appellant respectfully submits that each and every pending claim of the present application meets the requirements for patentability under 35 U.S.C. § 103 and 35 U.S.C. § 102, and that the present application and each pending claim are allowable over the prior art of record.

Respectfully submitted,
Andres SANCHEZ


Neil F. Greenblum
Reg. No. 28,394 

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October 12, 2004
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191

Attachments: Claims Appendix